

Application No. 10/035,985
Date of Response 1/27/2004
Reply to Action of 8/27/2003

REMARKS

This Amendment is being entered in response to the Office Action of August 27, 2003. In this Office Action, the Examiner made the following objections and rejections:

1. The Examiner has objected to claim 14 in formal grounds.
 2. The Examiner has rejected claims 1-18 as allegedly not enabling.
- Applicant respectfully requests reconsideration.

1. OBJECTION TO CLAIM 14 ON FORMAL GROUNDS

The Examiner has objected to claim 14 on formal grounds stating:

Claim 12 is objected to because of the following informalities: The meaning of the term "fro" in line 4 is unclear. Appropriate correction is required.

As per the Examiner's request, the applicants have amended claim 14 to replace the term "fro" with "for".

2. REJECTION OF CLAIMS 1-18 AS ALLEGEDLY NOT ENABLING

The Examiner has rejected claims 1-18 as allegedly not being enabling stating:

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most clearly connected, to make and/or use the invention. The term "microknife" has been used in conjunction with different medical fields. Ashraf (US 6,197,039 B1) describes the use of a microknife for hair transplant. Michelson (US 5,423,842) discloses the use of a microknife in spinal surgery. It is not clear as to the functionality and structure of the microknife recited in the instant specification. Applicant discloses that the microknife is used to harvest the fat cell beneath a person's skin before the cells can be converted to fatty acid and glycerol. It is therefore of imperative significance to understand how the microknife is operated and functioned. It is the position of the examiner that the disclosure fails to teach people of ordinary skill in the art as how the body fat is harvested and collected from the human body before it is converted to reactant gas for the fuel cell.

The applicants respectfully suggest the rejection of claims 1-4 and 6-19 is improper, as these terms do not contain the claim element the Examiner has objected to. The applicants note that the Examiner has objected to the claim element of a "microknife". The applicants respectfully suggest that this element appears only in claim 5. Claim 5 has no dependent claims. The applicants respectfully suggest that a rejection of claims 1-4 and 6-18 is improper, as these claims do not contain the claim element which the Examiner is rejecting.

The Test of Enablement is outlined in the M.P.E.P § 2164.01:

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The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? ..The test of enablement is whether one reasonable skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. A patent need not teach, and preferably omits, what is well known in the art."

Furthermore, M.P.E.P. § 2164.05(a) recites:

The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public....In general, if an applicant seeks to use a patent to prove the state of the art for the purpose of the enablement requirement, the patent must have an issue date earlier than the effective filing date of the application.

Applicants respectfully suggest that virtual cornucopia of surgical devices suitable for making precision cuts were easily available to one of ordinary skill in the art prior to the filing date of the applicants' application. By way of illustration, reference may be had to Carr et al. (United States Patent 5,980,518; issued on November 9, 1999), which discloses a "Microcautery Surgical Tool" that would be suitable for use in the instant invention. Furthermore, the "Brief Description of the Prior Art" references other precision cutting tools, dividing them into two classes ("microscalpels and laser scalpels). Additional examples of suitable microknives may be found by referencing Car et al. (United States Patent 5,792,137; issued on August 11, 1998) which discloses a "Coagulating Microsystem". A wide variety of surgical cutting instruments may serve as a microknife, all of which are routinely available to one of ordinary skill in the art. Applicants respectfully suggest that modification of any of these microsurgical instruments for use in the instant invention would not require one of ordinary skill in the art to partake in undue experimentation. To lessen the Examiner's burden, and in compliance with the aforementioned sections of the M.P.E.P., examples of microscalpels were omitted from the specification, as these devices were well-known to those skilled in the art as of the filing date of the application.

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Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. If, for any reason, the Patent Examiner believes that a telephone conference with applicant's agent might in any way facilitate the prosecution of this case, the Examiner is respectfully requested to call such agent.

Respectfully submitted,
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By 

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